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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reissue 553

Confirmation No. 5942

Application No. : 09/553,413

Applicant : Briere, et al.

Filed : April 20, 2000

Title : **BLOW MOLDING DEVICE FOR PRODUCING
THERMOPLASTIC CONTAINERS**

Art Unit : 1722

Examiner : Robert B. Davis

Docket No. : 11496/195086

Customer No. : 00826

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APPEAL BRIEF TRANSMITTAL

(37 C.F.R. § 1.192; Application for Reissue of a Patent)

1. Transmitted herewith, in triplicate, is the Appeal Brief to be filed in the above-identified application for reissue, with respect to the Notice of Appeal filed on January 7, 2004.
2. ☐ Applicant claims Small Entity status.
3. ☒ A Credit Card Payment Form PTO-2038 is enclosed authorizing payment of the Appeal Brief filing fee, in the amount of Three Hundred Thirty Dollars (\$ 330.00) as set forth in under 37 C.F.R. § 1.17(c).
4. ☒ Any required fees or refunds may be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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Application No. 09/553,413
Appeal Brief Transmittal
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APPEAL BRIEF

(37 C.F.R. § 1.192; Application for Reissue of a Patent)

This Appeal Brief in the above-identified application for reissue of U.S. Patent No. 5,968,560 is filed pursuant to the “Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences” which was filed on January 7, 2004.

1. REAL PARTY IN INTEREST

The real party in interest in this appeal is Sidel S.A. of Le Havre, France, the assignee of the above-referenced patent application. Sidel is a company of the Tetra Laval Group of Pully, Switzerland.

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03/15/2004 AWONDAF1-00000001 09553413
01 FC:1402 330.00 00

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals and/or interferences involving this application or its subject matter. A continuation of the subject reissue application was filed July 9, 2001, bears Application No. 09/902,475, and remains pending.

3. STATUS OF CLAIMS

Claims 1-14 were issued in U.S. Patent No. 5,968,560. Additional claims 15-40 were filed during prosecution of the application for reissue. Additional claims 22-33 were canceled. Claims 1-21 and 34-40 are pending.

Claims 1-21 and 34-40 are the subject of this appeal.

Claims 1-14 stand finally rejected under 37 C.F.R. § 1.175(b)(1) until a supplemental reissue declaration is provided. The Applicant will provide a supplemental reissue declaration.

Claims 15-21 and 34-40 stand finally rejected under 35 U.S.C. § 251 as being an improper recapture of subject matter surrendered during prosecution of the application for patent from which U.S. Patent No. 5,968,560 issued.

4. STATUS OF AMENDMENTS

No amendments were filed after the final rejection.

5. SUMMARY OF THE INVENTION

The present invention relates to improvements made to machines and articles of manufacture for use in the production by blow-molding of thermoplastic containers such as plastic bottles. Blow molding begins with a pre-heated tubular blank known in the art as a preform, which resembles a plastic test tube with a threaded neck. The preform is placed inside a mold or shell and then rapidly expanded using compressed air. In general, the improvements expedite the process of changing the inner mold or shell when a new container shape is desired.

The claims of U.S. Patent No. 5,968,560 are directed to a machine for manufacturing thermoplastic containers. The machine includes at least one mold assembly, which consists of two half-molds respectively supported by two mold carriers that can move one with respect to the other. Each half-mold comprises a shell and a shell holder. Each shell contains the half-impression of the container or bottle to be molded. In one embodiment, each shell may be removably fastened to its shell holder by quick-fixing means. Each shell holder, in one embodiment, includes internal pipes and connections for the circulation of cooling or heating fluids.

The claims added during reissue are directed to an article of manufacture – specifically, a mold assembly – for use with a machine for manufacturing thermoplastic containers. The mold assembly comprises two mold shells, two mold shell holders shaped to be supported by two mold carriers, and at least one quick-fixing locking member securing at least one shell to its respective shell holder.

STATEMENT OF FACTS

I. The Prosecution History of U.S. Patent No. 5,968,560

A copy of independent claim 1 (as originally presented) in the patent application that matured into U.S. Patent No. 5,968,560, appears in Appendix C along with a copy of claim 1 (as amended) with the amendment shown in bold.

U.S. Patent No. 5,968,560 (attached hereto in Appendix E) issued from an application filed under 35 U.S.C. § 371 and based upon an international application, which claimed priority to a French application filed April 19, 1995. The U.S. application was filed October 17, 1997, and assigned Application No. 08/945,089.

The first Office Action dated June 26, 1998, rejected all claims 1-13 as being indefinite under 35 U.S.C. § 112, ¶ 2, and obvious under 35 U.S.C. § 103(a) and unpatentable over U.S. Patent No. 4,072,456 issued to *Appel, et al.*, taken together with U.S. Patent No. 1,409,591 to *Schavoir* and others.

In response, the Applicant filed an “Amendment Under 37 C.F.R. § 1.115,” in which the only independent claim (claim 1; *see* Appendix C) was amended to add the phrase, “which are made in the form of enveloping structures and,” as shown below:

Claim 1. (amended) Device for manufacturing containers, ~~in particular bottles,~~ made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which are made in the form of enveloping structures and which can move one with respect to the other, characterized in that each half-mold (2) comprises a shell holder (9) supported by the respective mold

carrier (3) and a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23), the shell (7) and the shell holder (9) being in complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

(Applicant's "Amendment Under 37 C.F.R. § 1.115" at 2; attached hereto in Appendix F). The Applicant also submitted arguments traversing the obviousness rejection:

"Amended claim 1 defines a structure provided with mold carriers 3 which envelop or surround shell holders 9, wherein mold-carriers 3 are movable one with respect to the other, and in which shell holders 9 support a shell 7.

...

"In sum, neither *Appel* nor *Schavoir* teach or suggest a device including a three-part structure, i.e., including

- an enveloping mold carrier
- a shell holder
- a shell."

("Amendment" at 5, 7). Following entry of the Amendment, a Notice of Allowability was mailed and the application issued October 19, 1999, as U.S. Patent No. 5,968,560.

II. The Prosecution History of the Application for Reissue

On April 20, 2000, the application for reissue was filed, including original patent claims 1-14 without amendment and additional claims 15-33.

In a first Office Action, the Examiner rejected claims 22-31 as being anticipated under Section 102 or obvious under Section 103. The Examiner acknowledged, "Claims 1-21, 32 and 33 are allowed over the prior art of record." (Office Action dated Feb. 28, 2001, at 6).

A first Notice of Allowability issued March 22, 2001, following a first personal interview on March 22, 2001, during which the rejected claims 22-31 were canceled by an examiner's amendment.

A telephone interview was conducted on May 22, 2001, during which a substitute claim 15 was proposed, along with new claims 34-40. The claims were entered by examiner's amendment.

A second Notice of Allowability issued May 30, 2001, allowing all the pending claims, 1-21 and 32-40.

On November 8, 2001, a Petition to Withdraw the Application from Issue was filed, along with an Information Disclosure Statement with five (5) references brought to light during litigation then pending involving U.S. Patent No. 5,968,560.

On March 18, 2002, in a second Office Action, the Examiner withdrew the indicated the allowability of claims 32 and 33 under Section 103. The Examiner again acknowledged "Claims 1-21 and 34-40 are allowed over the prior art of record." Office Action dated March 18, 2002, at 2.

In response, the Applicant canceled claims 32 and 33. The Applicant expected a notice of allowability.

On June 18, 2002, however, in a third Office Action, the Examiner withdrew the indicated allowability of claims 15-21 and 34-40 as being an improper recapture under Section 251. The third Office Action marks the first time the recapture issue was raised.

On August 20, 2002, during a second personal interview, the Examiner agreed that adding the mold carrier shape limitation would overcome the recapture rejection:

“[Applicant] proposed to add the phrase ‘said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures’ to each of claims 15, 35, 36 and 39. The examiner agreed that this would overcome the recapture rejection set forth in paper number 26. The addition of the aforementioned phrase as a required characteristic of the mold shell holders is sufficient to prevent recapture of subject matter surrendered in the original prosecution.”

(Examiner’s second Interview Summary at 3; emphasis added). The Applicant again expected a notice of allowability.

On November 20, 2002, however, in a fourth Office Action, the Examiner reiterated the rejection of claims 15-21 and 34-40 as being an improper recapture under Section 251.

On January 9, 2003, during a third personal interview, the Examiner again agreed that the mold carrier shape limitation would overcome the recapture rejection:

“... the reissue claim is narrower than the surrendered subject matter (original presentation of claim in Patent application) in an aspect germane to the prior art rejection and broader in an aspect unrelated to the prior art

rejection, that is, broader in that it claims the corresponding subcombination (mold assembly). Reference was made to MPEP section 1412.02 and page 1400-15 citing *In re Clement*, 45 USPQ2d 1165. Since the claims in the reissue application already recite the limitation ‘said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures,’ the recapture rejection is hereby withdrawn and the case is in condition for allowance.”

(Examiner’s third Interview Summary at 3; emphasis added). As before, the Applicant again expected a notice of allowability.

On April 11, 2003, in a fifth Office Action, the Examiner withdrew the indicated allowability of claims 15-21 and 34-40 and reiterated the recapture rejection.

The Applicant filed a response May 30, 2003. On October 10, 2003, the Examiner issued a sixth and final Office Action, repeating the recapture rejection.

The Applicant filed a Notice of Appeal on January 7, 2004.

A copy of independent reissue claim 15, showing the amendments made during prosecution, appears in Appendix D alongside patent claim 1 (as issued), for comparison.

6. ISSUES

I. WHETHER THE REISSUE CLAIMS DO NOT RECAPTURE SURRENDERED SUBJECT MATTER BECAUSE THE MOLD CARRIER SHAPE CONTINUES TO BE A REQUIRED CHARACTERISTIC OF THE CLAIMED ARTICLE.

A. Whether the Reissue Claims Are Narrower Than the Surrendered Subject Matter, In an Aspect Germane to the Rejection.

B. Whether the Reissue Claims Are Broader Than the Surrendered Subject Matter, In an Aspect Unrelated to the Rejection.

7. GROUPING OF CLAIMS

Claims 1-21 and 34-40 are the subject of this appeal. Claims 1-14 are the original patent claims. Claims 15-40 were added during prosecution of the application for reissue. Claims 1-21 and 34-40 are pending. The independent claims are 1, 15, 35, 36, and 39.

With respect to the recapture rejection only, which is the sole issue in this appeal, claims 15-21 and 34-40 stand or fall together.

8. ARGUMENT

The Applicant and the Examiner agree that all the claims are patentably distinguishable and allowable over the prior art. (*See, e.g.*, the first Office Action dated Feb. 28, 2001, at 6; the first Notice of Allowability dated March 22, 2001; the second Notice of Allowability dated May 30, 2001; and, the second Office Action dated March 18, 2002, at 2). The only issue remaining to be decided in the application, and in this appeal, is whether the reissue claims recapture surrendered subject matter.

I. THE REISSUE CLAIMS DO NOT RECAPTURE SURRENDERED SUBJECT MATTER BECAUSE THE MOLD CARRIER SHAPE CONTINUES TO BE A REQUIRED CHARACTERISTIC OF THE CLAIMED ARTICLE.

The recapture rule does not bar the reissue claims because the narrowing amendment (the mold carrier shape) continues to be a required characteristic of the article in the reissue claims. The recapture rule “prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.” *Ex parte Eggert*, 67 U.S.P.Q.2d 1716, 2003 WL 21542454, at *11 (BD. PAT. APP. & INTERF. May 29, 2003), *quoting In re Clement*, 131 F. 3d 1464, 1468 (Fed. Cir. 1997). Analysis of the pending reissue claims using the *Clement* test confirms there is no recapture. The reissue claims are narrower because the mold carrier shape continues to be required, and broader because the claims recite an article of manufacture that corresponds to the machine claims in the patent.

The *Clement* recapture test includes two steps. First, whether the reissue claims are broader than the surrendered subject matter and in what respect. Second, whether those broader aspects of the reissue claims relate to the surrendered subject matter. The second step requires

analysis of the subject matter surrendered and whether the broadening aspect relates to the surrendered subject matter. The court in *Clement* stated the following principles:

(1) if the reissue claim is as broad as or broader than the canceled or amended claim [the surrendered subject matter] in all aspects, the recapture rule bars the claim;

(2) if it is narrower [than the surrendered subject matter] in all aspects, the recapture rule does not apply, but other rejections are possible;

(3) if the reissue claim is broader [than the surrendered subject matter] in some aspects, but narrower [than the surrendered subject matter] in others, then:

(a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;

(b) if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

Eggert at *13, quoting *Clement* at 1469-70. Applying the *Clement* test here, the pending reissue claims are an example of principle (3)(b) and the recapture rule therefore does not bar the claims.

A. The Reissue Claims Are Narrower Than the Surrendered Subject Matter, In an Aspect Germane to the Rejection.

The reissue claims are narrower because the mold carrier shape continues to be a required characteristic. Under the principles enumerated in *Clement*, category (3)(b) applies, “if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection” and the recapture rule does not bar the claim. *Eggert* at *13, *quoting Clement* at 1469-70. Because the mold carrier shape continues to be a required characteristic, the reissue claims are narrower than the surrendered subject matter.

The subject matter surrendered during prosecution of the machine claim was: a device without the enveloping characteristic of the mold carriers. Claim 1 was amended to add the phrase, “which are made in the form of enveloping structures.” Appendix C shows the original claim 1 and the amendment made during prosecution. In traversing the obviousness rejection, the Applicant argued, “neither *Appel* nor *Schavoir* teach or suggest . . . an enveloping mold carrier” (Amendment at 7). The amendment and traversal of the prior art rejection represents a surrender of a device that does not include the enveloping characteristic of the mold carriers.

The Examiner argues the reissue claims constitute recapture because the mold carrier shape is recited as a characteristic of the shell holders instead of as a separate structural element. “The shift [in the reissue claims] is recapture because the eliminated limitation of the ‘two mold carriers’ [was] the surrendered limitation to overcome a prior art rejection.” (Office Action dated Oct. 10, 2003, at 6). Reference to Appendix C, however, shows that the claim amendment

includes only the mold carrier shape: “made in the form of enveloping structures.” The two mold carriers were already present in the claim.

To support his argument, the Examiner cites *Pannu v. Storz Instruments*, 258 F.3d 1366 (Fed. Cir. 2001). In *Pannu*, the Applicant limited the shape of the claimed haptics by adding the new phrase “continuous, substantially circular arc” to claim 16. *Pannu* at 1371. The reissue claims eliminated the new phrase and instead claimed haptics having a length “substantially greater . . . [to] at least three times greater” than the width. *Id.* at 1372.

The Examiner’s argument that the “two mold carriers” were the surrendered subject matter is not supported by *Pannu* because the haptics in *Pannu* were not surrendered in order to overcome the prior art rejection. Instead, the surrendered subject matter was: any haptics not having the characteristic new shape of a “continuous, substantially circular arc.” The haptics element itself was not the surrendered subject matter in *Pannu*. Only the shape was limited. The haptics were already present in the claim. Thus, the facts of *Pannu* do not support the Examiner’s argument that the “two mold carriers” were surrendered in this case. The two mold carriers were present before and after the amendment.

The reissue claims are narrower than the surrendered subject matter because “shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures” adds the same limitation on the mold carrier shape, now as a characteristic of the shell holders. Appendix D shows a comparison between patent claim 1 and reissue claim 15. (Reissue claims 15, 35, 36, and 39 all include the same mold carrier shape limitation). Because

the characteristic shape is still required, the reissue claims are narrower than the rejected claim in an aspect germane to the prior art rejection.

The distinguishing characteristic of “mold carriers made in the form of enveloping structures” is present in both the patent claim and the reissue claims. The mold carrier shape continues to be required in the reissue claims. The Applicant did not surrender the option of claiming the same invention as an article of manufacture instead of a machine. Because the distinguishing characteristic continues to be required in the reissue claims, and because the mold carrier shape represents the same limitation that was added when the patent claim was amended, the reissue claims are narrower than the surrendered subject matter, in an aspect germane to the prior art rejection.

B. The Reissue Claims Are Broader Than the Surrendered Subject Matter, In an Aspect Unrelated to the Rejection.

The reissue claims are broader because they recite an article of manufacture corresponding to the machine claimed in the issued patent. Under the *Clement* recapture test, the first question is whether the reissue claims are broader than the surrendered subject matter and in what respect. *Clement* at 1468. Claiming an invention in a different statutory category is a broadening reissue, *see* MPEP § 1412.02, but in the present case, the shift in statutory category is unrelated to the prior art rejection made during prosecution.

The reissue claims recite the same patentable subject matter as the patent claim, but in a different statutory category. The patent claim recites a “device for manufacturing containers,” which is a machine under 35 U.S.C. § 101.¹ The reissue claims recite a “mold assembly,” which is a manufacture (or article of manufacture) under Section 101.²

A patentee may file a reissue application to permit consideration of claims written in a different statutory category where the reissue claims correspond to the patented claims. MPEP § 1412.02 (*see* Appendix G). The following paragraph of Section 1412.02 explains that the consideration of claims, presented in a different category, is proper in a reissue application:

¹ “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101.

² The Examiner argues that the mold assembly is not a separate statutory category, but is a subcombination in relation to the manufacturing device of Claim 1. The Applicant disagrees. The Examiner has cited no support for a conclusion that a subcombination cannot be a separate statutory category. A computer-readable medium containing software, such as a hard drive, is a good example of an article of manufacturer that might be considered a subcombination of a computing machine. *Compare* MPEP § 1412.02, discussed below.

MPEP § 1412.02. Reissue for Article Claims Which Are Functional Descriptive Material Stored on a Computer-Readable Medium.

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the “article” claims) must have been made as a result of error without deceptive intent. The addition of these “article” claims will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

MPEP § 1412.02 (emphasis in original). This paragraph of Section 1412.02 addresses the “statutory category change” situation in terms of seeking article claims (for the code on a drive) that correspond to the patented machine or process claims (for the software process). Similarly, here, the reissue claims being sought are article claims (for the mold assembly) that correspond to the patented machine claims (for the manufacturing device).

In the example described in Section 1412.02, the patented claims for a software process may include several steps, positively recited. For example, a software process claim may include, “storing said value in a database.” The article claims for the “functional descriptive material stored on a computer-readable medium” being sought in reissue may include, “said computer-readable medium configured to store said value in a database.” The step of storing is not positively recited in the article claims. Nevertheless, the medium must be configured to

carry out the storing step. The article claims may be properly sought in a reissue application if the error was made without deceptive intent.

Applying Section 1412.02 to the present case, the patented machine claim for a “device for manufacturing containers” includes several elements, positively recited:

“at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which are made in the form of enveloping structures”

(U.S. Patent No. 5,968,560, Claim 1; *see* Appendix D). The article claims for the “mold assembly” being sought in reissue include:

“two mold shell holders . . . said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures”

(Reissue Application, Claim 15; *see* Appendix D). Like the step of storing in the software example, the two mold carriers are not positively recited in the article claims. Nevertheless, the mold assembly must include shell holders configured to be supported by two mold carriers having an enveloping shape.

The shift in statutory category is unrelated to the prior art rejection made during prosecution for several reasons. First, the Applicant did not surrender the option of seeking corresponding article claims. The article claims may be properly sought in this reissue application because the error of not pursuing claims to the mold assembly article along was made

without deceptive intent. The Reissue Declaration expressly cites the lack of article claims such as “to the mold shells standing alone” as an error sought to be corrected through reissue.

Second, the presentation of article claims cannot be germane to the prior art rejection because the Examiner admitted the article claims are patentable over the prior art many times during prosecution of the reissue application. (First Office Action dated Feb. 28, 2001, at 6; First Notice of Allowability dated March 22, 2001; Second Notice of Allowability dated May 30, 2001; Second Office Action dated March 18, 2002, at 2; Examiner’s second Interview Summary at 3; Examiner’s third Interview Summary at 3). The Applicant and the Examiner agree that all the article claims are patentably distinguishable and allowable over the prior art.

The reissue claims are broader because they claim the invention in a different statutory category. The shift in statutory category is unrelated to the prior art rejection because the option of seeking corresponding article claims was not surrendered.

II. CONCLUSION

Under the *Clement* test and *Ex parte Eggert*, if the reissue claims are broader than the surrendered subject matter in some aspects and narrower than the surrendered subject matter in other respects, and if the reissue claim is narrower in an aspect germane to the prior art rejection and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim.

Eggert at *13; *Clement* at 1469-70. Applying this test to the pending reissue claims:


- The reissue claims are narrower than the patent claim prior to amendment (*i.e.*, narrower than the surrendered subject matter) in that the same enveloping characteristic of the mold carrier continues to be required in the reissue claims.
- The reissue claims are broader than the surrendered subject matter because the reissue claims are directed to an article of manufacture instead of a machine. *See* MPEP § 1412.02.
- The narrowing aspect (continuing to require the enveloping characteristic of the mold carriers) is germane to the rejection because the shape was limited by amendment and remains a required limitation in the reissue claims.
- The broadening aspect (claiming the article corresponding to the machine) is not germane to the rejection, because a change in statutory category is germane to the rejection, and the article claim is patentable over the prior art as determined by the Examiner in the reissue.


Accordingly, under *Clement* and *Ex parte Eggert*, the requirements of paragraph 3(b) of *Clement* test are satisfied and the recapture rule does not bar the reissue claims.

9. APPENDICES

Appendix A attached hereto includes a copy of all claims involved in the appeal. Additional appendices are provided for reference, as listed in the following Table of Appendices.

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Shana Moore

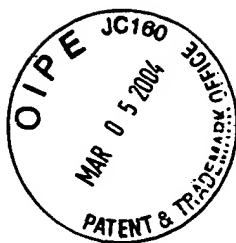


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